

REMARKS

Claims 1, 2, 4 to 13, 79 to 82, and 93 to 109 will be pending upon entry of the above-referenced amendments. Claims 1, 2, 4, 100 and 104 have been examined in the present Office Action. Claims 5 to 13, 79 to 82, 93 to 99, 101 to 103, and 105 to 108 have been withdrawn by the Office as directed to non-elected subject matter. Applicants propose to amend claim 1 without prejudice to recite, e.g., a shoulder that extends outwardly from the outer surface and disposed between the first and second ends, and a carrier-receiving portion at the first end comprising at least one flange that projects from the shoulder. Applicants propose to amend claim 100 to recite, e.g., a raised landing portion comprising a flat landing surface disposed within the carrier-receiving portion. Applicants also propose to add new claim 109. Support for the amendments and new claim can be found throughout the specification, e.g., at page 4, paragraphs 0060 and 0062 and Figure 8 of the published application. No new matter has been added.

Previous Office Actions/Replies

To provide a clear record, although the present Office Action does not explicitly do so, applicants assume that the previous rejection of claims 1 to 3 and 100 as allegedly anticipated by Ito (US Patent No. 5,063,025) and the previous rejection of claims 100 and 104 as allegedly anticipated by Baer et al. (WO99/17094) were withdrawn in view of applicants' arguments presented in their Reply filed on October 5, 2007.

35 U.S.C. §103

Claims 1 to 3 and 100 were rejected as allegedly obvious over Ito (US Patent No. 5,063,025) in view of Golias (US Patent No. 4,341,635). As an initial matter, applicants note that claim 3 was canceled in applicants' previous reply. This rejection is therefore moot as to that claim.

Applicants do not agree that Ito and Golias render the present claims obvious. However, in the interest of moving the present claims toward allowance, claim 1 has been amended without

prejudice to recite, e.g., a shoulder that extends outwardly from the outer surface and disposed between the first and second ends, and a carrier-receiving portion at the first end comprising at least one flange that projects from the shoulder. Claim 100 has been amended to recite a raised landing portion comprising a flat landing surface disposed within the carrier-receiving portion.

Ito describes an analytical microsyringe. Ito's microsyringe appears to lack such a shoulder as recited in amended claim 1. It also appears to lack a flange that projects from the shoulder. Thus, Ito fails to teach or suggest all of the elements recited in claim 1. Further, as Ito's syringe appears to lack a raised landing portion comprising a flat landing surface disposed within the carrier-receiving portion, as is recited in amended claim 100, it fails to teach or suggest all of the elements recited in that claim. No skilled practitioner would have gleaned from Ito, or anything else in the art, a reason to modify Ito such a way that it would include such features.

Golias does not remedy the shortcomings of Ito. According to the Office Action, the Office cites Golias to provide the flange that is missing from Ito. Specifically, according to the Office Action, Golias describes a microsyringe similar to Ito, but comprises a flange for gripping the syringe. However, Golias, like Ito, does not appear to teach or suggest a shoulder disposed between the first and second ends of the syringe and a flange that projects from the shoulder. Further, as Golias' syringe does not appear to include a raised landing portion comprising a flat landing surface disposed within the carrier-receiving portion, it does not provide the elements missing from Ito with respect to amended claim 100.

No skilled practitioner would have been motivated to combine Ito with Golias in an attempt to arrive at the present invention. Further, even if they did combine the two, the presently claimed extraction units still would not have been obtained because the references fail to teach or suggest all of the elements even when combined. Accordingly, neither Ito nor Golias, singularly or in combination, renders the present claims obvious. Applicants therefore respectfully request that the present rejection be reconsidered and withdrawn.

Claims 1, 2, 4, 100 and 104 were rejected as allegedly obvious over Baer et al. (WO99/17094) in view of Silverstolpe (U.S. Patent No. 2,649,245). Applicants respectfully traverse this rejection for the reasons discussed below.

Applicants do not agree that Baer and Silverstolpe render the present claims obvious. Further, applicants do not agree with any of the Office Action's statements in items 10, 11, and 12 at page 5 of the Office Action, e.g., statements regarding the "adapted to mate" limitation. However, in the interest of moving the present application toward allowance, applicants have amended claim 1 to recite, e.g., a shoulder that extends outwardly from the outer surface and disposed between the first and second ends, and a carrier-receiving portion at the first end comprising at least one flange that projects from the shoulder. Amended claim 100 recites a raised landing portion comprising a flat landing surface disposed within the carrier-receiving portion. Baer discloses, *inter alia*, a biological reaction vessel that includes an analysis vessel, e.g., a microcentrifuge tube, and a cap (see, e.g., Figs. 11A-11D). Applicants read the Office Action to construe Baer's analysis vessel as equivalent to applicants' extraction device. Baer's analysis vessel, which can be, *inter alia*, a microcentrifuge tube, does not include a shoulder and a flange that projects from the shoulder. It therefore fails to teach or suggest all of the elements recited in claim 1. Further, as Baer does not appear to include a raised landing portion comprising a flat landing surface disposed within the carrier-receiving portion, it fails to teach or suggest all of the elements recited in claim 100. No skilled practitioner would have gleaned from Baer, or anything else in the art, a reason to modify Baer to include such features.

Silverstolpe does not remedy the deficiencies of Baer. Silverstolpe describes, *inter alia*, improvements in stoppers as closing means for the end openings in vessels, e.g., centrifuge tubes (see Silverstolpe at col. 1, lines 1 to 7). Silverstolpe does not describe an extraction device that includes the elements discussed above. As it describes improved stoppers for centrifuge tubes, it would not have provided skilled practitioners with any reason to modify Baer's analysis vessel in an attempt to arrive at the present invention. Further, applicants again point out that Baer seeks to provide a laser capture microdissection (LCM) consumable that integrates an LCM film into the interior of an analysis container and to reduce the amount of contamination involved with the LCM technique (see, e.g., Baer at page 4, lines 20 to 25). Accordingly, no skilled practitioner would have found any reason in Baer, or anywhere else in the art (including Silverstolpe), to open Baer's analysis vessel and form an end adapted to mate with a second vessel. To do so would seem to destroy the purpose of Baer's device. Thus, applicants submit that no skilled

practitioner would have found any reason in Baer or Silverstolpe, or anywhere else in the art, to modify Baer's device with Silverstolpe's in an attempt to arrive at the present invention.

Further, applicants submit that even if Baer and Silverstolpe were combined, the combination would not have provided the present invention because neither of these references teaches or suggests all of the elements recited in the claims. At best, a skilled practitioner combining these two references would have obtained, e.g., Baer's analysis vessel with a stoppered end, which is not the invention recited in amended claims 1 and 100. Thus, no combination of Baer and Silverstolpe renders the present invention obvious.

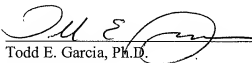
Accordingly, for the reasons discussed above, the Office has failed to establish a *prima facie* case of obviousness against the present claims. Applicants therefore request that the present rejection be reconsidered and withdrawn.

CONCLUSION

Applicants request that all rejections be reconsidered and withdrawn and that all claims be allowed. This Reply is being filed along with a Request for Continued Examination. The excess independent claim fee in the amount of \$105 is being paid concurrently herewith on the Electronic Filing System (EFS) by way of Deposit Account authorization. Please apply any other charges or credits to Deposit Account No. 06-1050, referencing attorney docket no. 14255-034001.

Respectfully submitted,

Date: March 27, 2008


Todd E. Garcia, Ph.D.
Reg. No. 54,112

Fish & Richardson P.C.
225 Franklin Street
Boston, MA 02110
Telephone: (617) 542-5070
Facsimile: (617) 542-8906